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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,368	03/26/2001	Kazuo Nakada	1466.1034	7332
21171	7590	12/03/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			SCHLAIFER, JONATHAN D	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/816,368	NAKADA ET AL.	
	Examiner	Art Unit	
	Jonathan D. Schlaifer	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 September 2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 3,5-9 and 11-15 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 3,5-9 and 11-15 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 26 March 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1.) Certified copies of the priority documents have been received.
 2.) Certified copies of the priority documents have been received in Application No. _____.
 3.) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/12/04, 9/16/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the amendment to application 09/816,368 filed on 9/16/2004, with prior art filed on 8/12/2004 and 9/16/2004.
2. Claims 3, 5-9, and 11-15 are pending in the case. Claims 1, 2, 4, and 10 have been cancelled. Claims 3 and 5-9 have been amended. Claims 11-15 are new claims. Claims 1, 3, 7, 9, and 10 are independent claims.
3. The rejection of claim 9 under 35 U.S.C. 101 as being directed to non-statutory subject matter is withdrawn as necessitated by amendment.

Claim Objections

4. Claim 5 objected to because of the following informalities: On line 8 of the claim “page information” should be “pieces of page information”. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 3, 9, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt et al. (USPN 6,603,839 B1—filing date 9/13/2000), hereinafter Brandt, further in view of Crandall (USPN 5,970,231—filing date 11/27/1996) further in view of Loeb et al. (USPN 6,014,641—filing date 12/11/1996), hereinafter Loeb.**
6. **Regarding independent claim 3, Brandt discloses in col. 4, lines 63-67 and col. 5, lines 1-23 An electronic information delivery system for delivering electronic information to a**

plurality of users (as noted in lines 1-5 of the Abstract, the invention works by transferring reports via telecommunications services), comprising: a database for storing the electronic information to be acquired (information is stored in customer databases in col. 1, lines 25-35); a selection information storing portion for storing selection information for each user (information is stored by user in the client databases, lines 25-35), (informational analysis occurs at col. 2, lines 10-25 via the Global Statistical Engine); an editing portion for searching and editing information necessary for each user using the selection information for each user from the information stored in the information database (user interaction via order entry occurs at col. 2, lines 45-50); a user-edited information storing portion for storing the information for each user edited using the selection information, the user-edited information storing portion being associated with a user relating to the selection information (given the edited portion at col. 2, lines 45-50, there would inherently be storage involved in the process, and it would have to be associated with a specific user in order to be useful); and a transmitting portion for transmitting the information stored in the user-edited information storing portion to a user relating to the newspaper information via a network (in figure 3, distribution of the information via an intranet is portrayed). Brandt fails to disclose that the information is newspaper information, since Crandall discloses in the Abstract, lines 1-15 the use of an electronic device to disseminate, to organize and regulate the large amounts of data found in a newspaper operation, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the invention of Brandt, which already satisfies many of the other limitations of the claim, since Crandall's feature

would have allowed organizing and regulating the large-scale amounts of data in the context of Brandt's invention in an efficient and organized manner (which would have been found in a newspaper operation). Brandt further fails to disclose the selection information being used for selecting newspaper information of a kind of a newspaper page to be read for each publisher, and that the editing portion edits the newspaper information for each user and for each newspaper page of each publisher. However, Loeb, in Claim 32 (col. 15, lines 15-20) describes the acquisition and use of publisher information to effectively manage publisher transactions in an organized and uniform manner. It would have been obvious to one of ordinary skill in the art at the time of the invention to use in Brandt's invention publisher information as described in Loeb to effectively manage publisher transactions in an organized and uniform manner.

7. **Regarding independent claim 9**, it is a computer program product for running a system as in claim 3 and it is rejected under similar rationale.
8. **Regarding independent claim 14**, it is an apparatus with the same function and operation as the system of claim 1 and it is rejected under similar rationale.
9. **Regarding independent claim 15**, it is the method performed by the system of claim 1 and it is rejected under similar rationale.
10. **Claim 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt, further in view of Crandall, further in view of Loeb, further in view of Reddington (USPN 4,554,631—filing date 7/13/1983).**
11. **Regarding dependent claim 5**, Brandt, Crandall, and Loeb fail to disclose a system wherein means for assigning a keyword to the newspaper information to be stored in the

newspaper database are provided, the selection information includes a keyword selected by the user, and the editing portion searches necessary newspaper information from the newspaper information stored in the newspaper database in accordance with the keyword included in the selection information and edits the searched newspaper information as clipping information that is different from each newspaper information that was each of the pieces of page information. However, Reddington, in the Abstract, lines 1-15, details how database searching can be carried out using keywords to screen information for retrieval purposes in a specific manner. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used keywords in the invention of Brandt, Crandall, and Loeb in the manner of Reddington since Reddington's feature would have provided the screen information for retrieval purposes in a specific manner.

12. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt, further in view of Crandall, further in view of Loeb, further in view of Hotti (USPN 6,144,941—filing date 2/24/1998).

13. Regarding dependent claim 6, Brandt, Crandall fail to disclose a bulletin database for storing bulletin information that is published by the publisher, the newspaper information being transmitted to a user twice at predetermined times in the morning and in the evening of the current day, and newly-published bulletin information is transmitted to a user without delay. However, Hotti discloses in col. 5, lines 15-45, a bulletin board with synchronized transmission of information to update a target destination with up-to-date data. Further, it was notoriously well known in the art at the time of the invention that

synchronization at the beginning and end of the day is useful because it coincide with backup needs of the the business cycle. Hence, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Hotti's bulletin board into the inventions of Brandt and Crandall in order to provide up-to-date data for the target data system and incorporate transmissions during the morning and evening because these would coincide with backup needs of the business cycle.

14. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt, further in view of Crandall, further in view of Loeb, further in view of Shibata et al. (USPN 5,835,923—filing date 3/14/1996), hereinafter Shibata.

15. Regarding dependent claim 7, it is the same as claim 3 except for the limitations of a plurality of user terminals provided in each user being connected with the newspaper information host system via the network, each of the user terminals including a memory device for story newspaper information received from the newspaper information host system, and a display device for displaying the newspaper information stored in the memory device. Brandt and Crandall fail to disclose these limitations. However, Shibata, in Figure 2, discloses Newspaper On-Demand Terminals in a network that inherently have displays and memories in order to facilitate the dissemination of the newspaper to its audience by increasing its availability. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the network architecture of Shibata into Brandt and Crandall in order to facilitate the dissemination of the newspaper to its audience by increasing its availability.

- 16. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt, further in view of Crandall, further in view of Loeb, further in view of Shibata, further in view of Van den Heuvel et al. (USPN 5,301,359—filing date 3/9/1993), hereinafter Van den Heuvel.**
- 17. Regarding dependent claim 8,** Brandt, Crandall, and Shibata fails to disclose that the display device of the user terminal displays the newspaper information for each page, and the display device displays a message indicating that a new bulletin information is received. However, Van den Heuvel discloses in col. 4, lines 45-65 the use of indicators with bulletin board systems to provide useful feedback about the status of the bulletin board. It would have been obvious to one of ordinary skill in the art at the time of the invention to use indicators in the manner of Van den Heuvel to provide useful feedback about the status of the bulletin board.
- 18. Claim 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt, further in view of Crandall, further in view of Loeb, further in view of Sutcliffe et al. (USPN 6,058,367—filing date 6/13/1997), hereinafter Sutcliffe.**
- 19. Regarding dependent claim 11,** Brandt, Crandall and Loeb fail to disclose that the editing portion allocates advertisement data that are different for each newspaper page. However, Sutcliffe discloses the use of variable-content personal ads on newspaper pages in order to allow users to meet other people, which must have been put there by an editor. It would have been obvious to one of ordinary skill in the art at the time of the invention to use variable content personal ads on newspaper pages in order to allow users to meet other people.

20. **Regarding dependent claim 13**, it modifies claim 9 in the manner in which claim 11 modifies claim 3 and is rejected under similar rationale.

21. **Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt, further in view of Crandall, further in view of Loeb, further in view of Shibata, further in view of Sutcliffe.**

22. **Regarding dependent claim 12**, it modifies claim 7 in the manner in which claim 11 modifies claim 3 and is rejected under similar rationale.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPN 6,253,188 B1 (filing date 9/20/1996)—Witek et al.

USPN 5,710,884 (filing date 3/29/1995)—Dedrick

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

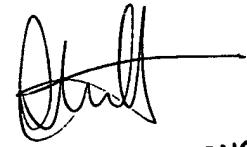
however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan D. Schlaifer whose telephone number is (571) 272-4129. The examiner can normally be reached on 8:30-5:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS



STEPHEN S. HONG
PRIMARY EXAMINER